

REMARKS

Applicant requests favorable consideration and allowance of this application in view of the foregoing amendments and the following remarks.

Claims 24-26, 30-32, 38-40, 43, 44, 46, 51, 64-66, 68, 69, 74, 79, and 80 are pending in this application, with Claims 24, 46, and 64 being independent. Claims 24, 46 and 64 have been amended. Applicant submits that support for the amendments can be found in the original disclosure and therefore no new matter has been added.

Claims 24-26, 30-32, 38-40, 43, 44, 46, 51, 64-66, 74, 79, and 80 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,301,881 (Fukatsu) in combination with U.S. Patent No. 4,370,649 (Fuerle).

In response, while not conceding the propriety of the rejection, independent Claims 24, 46, and 64 have been amended. Applicant respectfully submits that as amended, these claims are allowable at least for the following reasons.

As recited in amended independent Claim 24, the present invention includes, *inter alia*, the features of receiving price information provided via a network along with electronic information by an information provider terminal, the price information indicating a charge for use of the electronic information.

In contrast, neither the patent to Fukatsu, nor the patent to Fuerle is understood to disclose or suggest the receiving of price information provided via a network along with electronic information by an information provider terminal, the price information indicating a charge for use of the electronic information, as recited by amended Claim 24. And since MPEP § 2142 and

§ 2143 require the cited art to disclose or suggest *all* the claimed features to establish a prima facie case of obviousness, and since the Office is not understood to have done so, Applicant submits that the Office has not yet established a prima face case of obviousness against amended Claim 24.

The February 23, 2006 Advisory Action states that Applicant's previous response does not place the application in condition for allowance because non-obviousness cannot be established by providing a reference-by-reference attack upon the cited art. But MPEP § 2142 places the initial burden of proof on the Office to establish a prima facie case of obviousness, and it cannot be established if the Office fails to cite art showing *all* the claimed features as Applicant previously established:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

. . . .

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* (emphasis added)

Here, as noted above, the patents to Fukatsu, and Fuerle are not understood to disclose or suggest the price-information receiving step of amended Claim 24. Thus, one of the criteria for establishing a prima face case of obviousness has not been established against Claim 24.

Therefore, the Office is not understood to have satisfied its burden of proof to establish a prima facie case of obviousness against amended Claim 24 and for this reason Applicant respectfully requests that the rejection of Claim 24 over these patents be withdrawn.

Applicant will now discuss the teachings of each reference to establish that they do not show or suggest the price-information receiving step of amended Claim 24.

Fukatsu is understood to disclose a POS (point of sale) system that, as is understood to be shown in Fig. 15, includes a mainframe computer 155, a cash register 100, and a host computer 159. The cash register is connected to each of the computers 155 and 159. The function of the disclosed system is understood to be cash management of sales transactions at, for example, department stores, supermarkets, and the like. In the system disclosed in Fukatsu, electronic information is not understood to be provided via a network by an information provider terminal, and price information indicating a charge for use of electronic information is not understood to be provided via a network along with the electronic information.

The Office Action concedes that Fukatsu does not disclose at least the feature of inputting price information provided via a network along with electronic information by an information provider terminal, the price information indicating a charge for use of the electronic information. However, the Office Action asserts that Fuerle discloses that feature.

Applicant respectfully submits that Fuerle does not does disclose or suggest at least this feature or the feature now claimed, i.e., a step of receiving price information provided via a network along with electronic information, and therefore that patent adds nothing to the teachings of Fukatsu that would render obvious the present invention. The Office Action cites specifically to column 2, lines 14-31 of Fuerle as allegedly disclosing the above-mentioned feature. However, the cited text is understood to merely disclose that a “system builder” can calculate expenses, including central processor time and number of phone calls, to more readily plan a system. Different usage rates can be charged for display terminals that update information at different rates. For example, a significantly higher price may be charged for a terminal that is updated at

five minute intervals or upon every change of data than the price charged for a terminal that displays information updated only hourly. Thus, Applicant submits that the cited portion of Fuerle discloses only that different prices may be charged for different terminals, and does not disclose or suggest that price information is provided via a network along with electronic information. Moreover, Applicant submits that the prices mentioned in Fuerle are prices for the use of *terminals*, depending on the rate the displayed data is updated, and not price information indicating a charge for use of the electronic information.

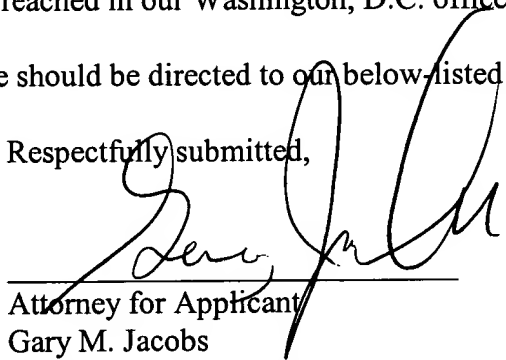
Applicant submits that the remaining portions of Fuerle also fail to disclose or suggest at least the above-mentioned claimed feature. Fig. 4, for example, discloses that when money is deposited a decision is made as to whether enough money has been paid for the selected information to be displayed. However, Applicant submits that Fuerle fails to disclose or suggest the step of receiving price information provided via a network along with electronic information by an information provider terminal, the price information indicating a charge for use of the electronic information.

Thus, Applicant submits that the cited art fails to disclose or suggest *all* the claimed features, and therefore, the Office has not yet established a prima facie case of obviousness against amended Claim 24 under MPEP § 2142 and § 2143. For this reason, Applicant respectfully requests that the rejection of Claim 24 be withdrawn. Amended independent Claims 46 and 64 recite features similar to Claim 24 and are believed patentable for reasons similar to Claim 24. The dependent claims are believed patentable for at least the same reasons as the claims they depend from, as well as for the additional features they recite.

In view of the foregoing, Applicant submits that this application is in condition for allowance. Favorable reconsideration, withdrawal of the outstanding rejection, and an early Notice of Allowance are requested.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should be directed to our below-listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gary M. Jacobs", is written over a horizontal line.

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